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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,916	01/30/2004	Jean-Louis Gueret	118335	5691
25944	7590	01/18/2008	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			PICKETT, JOHN G	
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
01/18/2008		PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/766,916
Filing Date: January 30, 2004
Appellant(s): GUERET, JEAN-LOUIS

| MAILED
JAN 18 2008
Group 3700

William P. Berridge
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26 October 2007 appealing from the Office action mailed 29 May 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 3,441,033	FLAX	04-1969
US 5,115,916	BEASLEY et al.	05-1992
US 5,878,881	HUNT	03-1999
US 6,216,899	VICARI	04-2001
US 2002/0153376	SEIDLER	10-2002
US 6,626,432	RAGO et al.	09-2003 [102(e) 09-2001]
US 7,047,983	MANOUGIAN et al.	05-2006 [102(e) 03-2002]

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 11, 12, 14, 15, 17-21, 24, 26-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian et al (US 7,047,983 B2; hereinafter Manougian) in view of Rago et al (US 6,626,432 B2; hereinafter Rago).

Claim 1: Manougian discloses a box **210** (see Figure 7) comprising a base portion **218**, a lid **216**, and a hinge **220**. Manougian discloses the claimed invention except that Manougian uses a pinned hinge instead of a hook-and-loop hinge.

Rago discloses a hinge **22** (see Figure 6) with a first element **62** comprising loop materials and a second element **72** comprising hook materials. Rago shows that a hook-and-loop hinge was an equivalent structure known in the art. Therefore, because these two hinge means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hook-and-loop of Rago for the pinned hinge of Manougian. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Manougian, as modified with the hinge of Rago, is fully capable of holding the lid in an upstanding position.

Claims 2, 17, 18, and 21: An interpretation of Manougian discloses a base portion **218** with a top face **258** and rear face (sidewall near hinge **220**), and a lid with a bottom face **264** and rear face (sidewall near hinge **220**). Rago teaches the hook-and-loop fastener wrapping around the top, side, and bottom of the base and lid (see Figure 6), and it would have been obvious to include the wrap-around feature in the combination of Manougian-Rago in order to enable the pivoting feature.

Claim 3: An interpretation of Manougian discloses a base portion **218** with a top face (portion holding third element **256'** of hook or loop material), and a lid **216** with a bottom face (portion holding fourth element **254'** of hook or loop material).

Claims 11 and 12: Manougian-Rago discloses the claimed invention except for the shape of the first element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the first element of Manougian-Rago

with the claimed wedge shape in order to conform to the increasing diameter of the base. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

Claims 14, 15, 19, and 20: Base **218** of Manougian is a semi-circular cylinder; therefore the first element of the hook-and-loop hinge would comprise a fraction fixed on a surface that is not planar.

Claim 24: Manougian discloses relief portion **258** and cooperating portion **264**.

Claims 26, 27, and 36: Manougian discloses housing **252** containing substance **214** that is a cosmetic substance; housing **252** is a dish.

Claim 28: Manougian discloses housing **242** with applicator **244** located on the lid portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the housing and applicator in the base portion in order to allow for a larger mirror. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 29: Manougian discloses housing **252** having a bottom comprising one of hooks and loops **256**.

Claims 30 and 31: Manougian discloses mirror **240** on a bottom face of lid **216**.

Claim 34: Manougian discloses box **210** as a cosmetic box (see for example the Abstract).

Claim 35: Manougian-Rago discloses the claimed structure, and Rago teaches the obvious use of the hook-and-loop hinge (see Col. 3, lines 50-55).

Claims 4-6, 25, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian-Rago as applied to claims 1 and 3 above, and further in view of Flax (US 3,441,033) and Hunt (US 5,878,881; provided by appellant).

Manougian-Rago discloses the claimed invention except for the stacking base with hook-and-loop attachment.

Flax teaches a stacking base **12/14/16**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Manougian-Rago with a stacking base as taught by Flax in order to retain a larger number of articles. Flax also suggests cooperating relief's **32/38**.

Hunt teaches the use of hook-and-loop fasteners **66/68** for the connection of multiple bases **24** (see Figure 17) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Manougian-Rago with hook-and-loop fasteners on the bottom of base **218** as taught by Hunt in order to hold the plurality of bases together.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manougian-Rago as applied to claim 1 above, and further in view of Beasley et al (US 5,115,916; hereinafter Beasley).

Manougian-Rago discloses the claimed invention except for the setback portion.

Beasley teaches a hook-and-loop fastener placed in a setback portion (see Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the hook-and-loop hinge of Manougian-Rago in a setback portion as taught by Beasley in order to accurately locate the hinge parts during assembly.

Claims 1, 2, 7-10, 13, 17, 18, 21, 26-28, 30-36, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidler (US 2002/0153376 A1) in view of Rago et al (US 6,626,432 B2; hereinafter Rago).

Claim 1: Seidler discloses a box **30** with at least one base portion **34**, a lid **32**, and a hinge **16/18** comprising first element **18** and second element **16** and capable of retaining the lid in an upstanding position (see Figure 13). Seidler discloses the hinges as magnets instead of the hook-and-loop fasteners claimed by the appellant.

Rago discloses a hinge **22** (see Figure 6) with a first element **62** comprising loop materials and a second element **72** comprising hook materials. Rago shows that a hook-and-loop hinge was an equivalent structure known in the art. Therefore, because these two hinge means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hook-and-loop of Rago for the magnets of Seidler. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Claims 2, 17, 18, and 21: Rago teaches the hook-and-loop fastener wrapping around the top, side, and bottom of the base and lid (see Figure 6), and it would have been obvious to include the wrap-around feature in the combination of Manougian-Rago in order to enable the pivoting feature.

Claims 7-10: Seidler discloses two complementary, distinct hinge portions disposed at opposite side faces of the base and lid.

Claim 13: Upper and lower portions of the base and lid of Seidler are planar and Rago teaches wrapping the hook-and-loop material around the planar portions.

Claims 26, 27, and 36: Seidler discloses housing with cosmetic substance **38** contained in a dish **40**.

Claim 28: Seidler discloses housing **42**.

Claims 30 and 31: Seidler discloses mirror **36** on a bottom face of lid **32**.

Claim 32: Seidler discloses second base portion **50**.

Claim 33: The hinge elements are removable, and therefore considered movable.

Claim 34: Box **30** of Seidler is a cosmetic box.

Claim 35: Seidler discloses the claimed method of use (see Figure 4).

Claims 38 and 39: Seidler discloses a system comprising a first base portion **34** including a housing receiving at least one cosmetic substance **38**, a second base portion **50** including a housing receiving at least one cosmetic substance **38** (see paragraph [0052]), the first and second base portions having the claimed face arrangements, a lid **32**, a hinge **16/18/52** comprising first element **18**, second element

16. Seidler discloses the hinges as magnets instead of the hook-and-loop fasteners claimed by the appellant.

Rago discloses a hinge **22** (see Figure 6) with a first element **62** comprising loop materials and a second element **72** comprising hook materials. Rago shows that a hook-and-loop hinge was an equivalent structure known in the art. Therefore, because these two hinge means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hook-and-loop of Rago for the magnets of Seidler. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Seidler discloses two complementary, distinct hinge portions disposed at opposite sides of the base, second base, and lid, at least two of which may be considered cooperating third and fourth elements.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidler-Rago as applied to claim 1 above, and further in view of Vicari (US 6,216,899).

Seidler-Rago discloses the claimed invention except for the hook-and-loop catch. Vicari teaches a tab **30'** of one of hook or loop material and a catch **20'** of the other of hook or loop material for securing the lid in a closed position and for said purpose, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the box of Seidler-Rago with a tab and catch as taught by Vicari.

(10) Response to Argument

In argument A-1, appellant contends that the combination of Manougian-Rago is unreasonable. Appellant argues that there is no suggestion or motivation in Manougian to modify the hinge. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Appellant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Appellants have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art. A hinge is one of the most basic of mechanical elements and the simple substitution of one known hinge arrangement for another known hinge arrangement is well within the level of ordinary skill in the art. It respectfully asserted that the claim is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another.

In response to appellant's argument that Rago is nonanalogous art, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rago is reasonably pertinent to hinges (see Col. 3, lines 51-55), and more particularly separable hinges.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to the appellant's assertion that the combination would somehow render the device of Manouelian, a hinge is one of the most basic of mechanical elements and the simple substitution of one known hinge arrangement for another known hinge arrangement is well within the level of ordinary skill in the art and would in no way render the receptacle of Manouelian unusable.

In argument B-1, appellant contends that the combination of Seidler-Rago is unreasonable. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

In response to appellant's argument that Rago is nonanalogous art, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rago is reasonably pertinent to hinges (see Col. 3, lines 51-55), and more particularly separable hinges.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to the appellant's assertion that the hinge of Rago is not equivalent and would render the device of Seidler unsuitable for its intended use, Rago is a "virtual" hinge in that no set pivot axis is provided (see e.g. Figure 6). Both structures are "virtual" hinges and the substitution of one hinge arrangement for the other would in no way render the device of Seidler unsuitable.

In argument **B-2-a**, appellant argues that there is no motivation for combining Seidler with Rago. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

As to the feature of holding the lid in a particular position, Seidler already discloses this arrangement (see Figure 13), and the hinge of Rago would be fully capable of also performing this feature since the hook-and-loop portions wrap around the edges.

In argument **B-2-b**, appellant argues that Seidler does not have third and fourth elements on the lateral side. Both appellant's invention and Seidler are rectangular, and the portion of Seidler retaining the hinge area may be considered a "lateral side". The claim requires no location for the first and second hook-and-loop elements, so they

may also be located on the "lateral" side. Seidler discloses four hinge parts **16/18** on two different ends of a side of the rectangular base and lid (see e.g. Figure 1).

Replacement of the magnets **16/18** with corresponding hook-and-loop elements would also have four parts on two ends of a side, any of which may be considered a "third element". Any of the sides may be considered a "lateral" side. Seidler also has a second base portion **50** (see e.g. figures 9-13) under the first base portion **34** and an additional pair of hinge parts **52** on two ends of a side of the rectangular base, either of which may be considered a "fourth element".

In argument **B-2-c**, appellant argues that Rago fails to disclose a third section. This is irrelevant since the base reference Seidler clearly discloses this feature (see e.g. Figures 9-13). An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Further, both appellant's invention and Seidler are rectangular, and the portion of Seidler retaining the hinge area may be considered a "lateral side". The claim requires no location for the first and second hook-and-loop elements, so they may also be located on the "lateral" side. Seidler discloses four hinge parts **16/18** on two different ends of a side of the rectangular base and lid (see e.g. Figure 1). Replacement of the magnets **16/18** with corresponding hook-and-loop elements would also have four parts on two ends of a side, any of which may be considered a "third element". Any of the sides may be considered a "lateral" side. Seidler also has a second base portion **50**

(see e.g. figures 9-13) under the first base portion **34** and an additional pair of hinge parts **52** on two ends of a side of the rectangular base, either of which may be considered a "fourth element".

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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